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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,144	06/23/2000	Gregory Jones	5053-28000	1593

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EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/603,144

Applicant(s)

JONES ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 41-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13 and 14. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/10/03 has been entered.

### **Notice to Applicant**

2. This communication is in response to the RCE filed on 11/10/03. Claims 1-40 have been cancelled. Claims 41-70 are pending.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 41-70 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technology arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

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For a claimed invention to be statutory, the claimed invention must be within the technology arts. More ideas, in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts to promote the "progress science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. Looking at the claims 41-70 as a whole, nothing in the body of the claims recite any structure of functionality to suggest that a computer performs the recited steps.

As such, the above deficiencies may be cured by simply explicitly reciting that the claimed method/process steps are embodied or implemented on a "computer system" or on a "computer readable medium" (as appropriate), provided Applicant show proper support for such recitations in the originally filed specification.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 41-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (4,987,538) in view of McKee et al (6,272,482).

(A) As per claim 41, Johnson discloses a system comprising: a database comprising a plurality of business rule data elements(Col.3, lines 8-49 to Col.4, line 41); a translator program configured to read two or more business rule data elements from the database and to combine two or more business rule data elements to form at least one business rule (Col.3, lines 8-49 to Col.4, line 41).

Johnson does not explicitly disclose a rules engine configured to assess a value of an insurance claim as a function of at least one business rule formed by the translator program.

However, this feature is known in the art, as evidenced by McKee. In particular, McKee suggests a rules engine configured to assess a value of an insurance claim as a function of at least one business rule formed by the translator program (See McKee Col.4, lines 25-67 to Col.5, line 52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of McKee within the system of Johnson with the motivation of providing a method and system for managing business rules, which facilitates an understanding of the interactions of business rules, and simplifies revision of the rules as required by changes in business procedures and policies (See McKee Col.2, lines 50-53).

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(B) As per claim 42, Johnson discloses the system wherein the insurance claim comprises a bodily injury claim, and wherein the value of the insurance claim comprises a trauma severity value (Col.1, lines 13-57).

(C) As per claim 43, Johnson discloses the system wherein the plurality of business rule data elements are stored in a tabular format in the database (Col.3, lines 8-67 to Col.4, line 67).

(D) As per claim 44, Johnson discloses wherein at least one business rule comprises logical instructions for assessing the value of the insurance claim (Col.3, lines 8-67 to Col.4, line 67).

(E) As per claim 45, McKee discloses the system wherein at least one business rule comprises a premise and one or more resulting actions for assessing the value of the insurance claim (See McKee Col.4, lines 25-67 to Col.5, line 52).

(F) As per claim 46, McKee discloses the system wherein the business rule data elements comprise alphanumeric values stored in the database (Col.5, lines 53-67 to Col.6, line 67).

(G) As per claim 47, Johnson discloses a method comprising: providing a plurality of business rule data elements in a memory of a computer system, wherein two or more of the business rule data elements are combinable to form at least one business rule

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(Col.2, lines 1-68 to Col.3, line 25); combining two or more business rule data elements of the plurality of business rule data elements to form at least one business rule for processing an insurance claim (Col.2, lines 1-68 to Col.3, line 25).

Johnson does not explicitly disclose providing at least one formed business rule to a rules engine, wherein at least one formed business rule is executable by the rules engine to process at least one insurance claim.

However, this feature is known in the art, as evidenced by McKee. In particular, McKee suggests providing at least one formed business rule to a rules engine, wherein at least one formed business rule is executable by the rules engine to process at least one insurance claim (See McKee, Col.1, lines 15-67 to Col.2, line 40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of McKee within the system of Johnson with the motivation of providing a method and system for managing business rules, which facilitates an understanding of the interactions of business rules, and simplifies revision of the rules as required by changes in business procedures and policies (See McKee Col.2, lines 50-53).

(H) As per claim 48, McKee discloses the method further comprising processing at least one insurance claim by executing at least one formed business rule in the rules engine (Col.1, lines 15-67 to Col.2, line 40).

(I) As per claim 49, Johnson discloses the method wherein at least one insurance claim comprises a bodily injury insurance claim (Col.1, lines 13-57).

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(J) As per claim 50, Johnson discloses the method wherein at least one formed business rule is executable by the rule engine to assess a trauma severity value of a bodily injury insurance claim (Col.1, lines 13-57).

(K) As per claim 52, Johnson discloses the method wherein the rules engine comprises program instructions which are executable by a computer to access at least one formed business rule and to assess an insurance claim based on at least one accessed business rule (Col.5, lines 31-68 to Col.5, line 68; Col.6, line 35-68).

(L) As per claim 55, Johnson discloses the method further comprising: modifying at least one business rule data element in the memory and combining at least two business rule data elements, including at least one modified business rule data element, to form at least one modified business rule (Col.2, lines 56-68 to Col.3, line 25).

(M) As per claim 56, Johnson discloses the method further comprising: modifying at least one business rule data element as function of business requirements of an insurance organization (Col.2, lines 56-68 to Col.3, line 25).

(N) As per claim 57, Johnson discloses the method further comprising: modifying at least one business rule in response to modifying at least one business rule data element (Col.2, lines 56-68 to Col.3, line 25).



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(O) As per claim 58, Johnson discloses the method further comprising: forming at least one new business rule in response to modifying at least one business rule data element (Col.2, lines 56-68 to Col.3, line 25).

(P) As per claim 59, Johnson discloses a carrier medium comprising program instructions, wherein said program instructions are computer-executable to implement: providing a plurality of business rule data elements in a memory of a computer system, wherein two or more of the business rule data elements are combinable to form at least one business rule (Col.2, lines 1-68 to Col.3, line 25); combining two or more of the business rule data elements of the plurality of business rule data elements to form at least one business rule for processing an insurance claim (Col.2, lines 1-68 to Col.3, line 25).

Johnson does not explicitly disclose providing at least one formed business rule to a rules engine, wherein at least one formed business rule is executable by the rules engine to process at least one insurance claim.

However, this feature is known in the art, as evidenced by McKee. In particular, McKee suggests providing at least one formed business rule to a rules engine, wherein at least one formed business rule is executable by the rules engine to process at least one insurance claim (See McKee, Col.1, lines 15-67 to Col.2, line 40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of McKee within the system of Johnson with the motivation of providing a method and system for managing business rules, which facilitates an understanding of the interactions of business rules, and simplifies revision

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of the rules as required by changes in business procedures and policies (See McKee Col.2, lines 50-53).

(Q) As per claim 60, Johnson discloses the carrier medium wherein the program instructions are further computer-executable to implement processing at least one insurance claim by executing at least one formed business rule in the rules engine (Col.2, lines 1-68 to Col.3, line 25).

(R) Claims 51, 53-54, and 61-70 recite the underlying process steps of the elements of claims 43, 45-46, 49-52 and 55-58. As the various elements of claims 43, 45-46, 49-52 and 55-58 have been shown to be either disclosed by or obvious in view of the collective teachings of Johnson and McKee, it is readily apparent that the carrier-medium disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 51, 53-54, and 61-70 are rejected for the same reasons given above for claims 43, 45-46, 49-52 and 55-58, and incorporated herein.

### **Response to Arguments**

7. Applicant's arguments filed 11/10/03 regarding claims 41-70 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in response filed 11/10/03.

(A) At pages 8-13 of the 11/10/03 response, Applicant argues that the features in the 11/10/03 amendment are not taught or suggested by the applied references.

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In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 11/10/03 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Johnson and McKee, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 10), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

#### Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches case management for a personal injury plaintiff's law office using a relational database (6,098,070); method and apparatus for deterring frivolous professional liability claims (6,272,471) and insurance claims estimate, text, and graphics network and method (5,504,674).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers


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for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F  
V.F

January 24, 2004

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
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